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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,485	10/30/2003	Edward J. Stashluk JR.	067439.0138	7404
5073	7590	06/13/2006	EXAMINER	
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980				MISIASZEK, MICHAEL
ART UNIT		PAPER NUMBER		
		3625		

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/697,485	STASHLUK ET AL.	
	Examiner Michael Misiaszek	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 31 March 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 7-32 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-6 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 October 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                                       |                                                                             |
|-------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                           | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                                  | Paper No(s)/Mail Date. _____                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/2/04, 10/30/03</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                                                       | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

***Response to Amendment***

Applicant's election without traverse of the Restriction Requirement in the reply filed on 3-31-06 and in a subsequent telecom by Examiner Rob Rhode with Ms. Moen on 4-7-06 in which species Ia. (claims 1 – 6) was elected and is acknowledged.

Claims 7 – 32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3-31-06.

The requirement is still deemed proper and is therefore made FINAL.

***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**1. Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Hauser (US 6,536,659 B1).**

Hauser discloses a method, performed by a returns provider, handling customer returns of items on behalf of multiple merchants, comprising the steps of:

- storing a set of merchant returns rules in a processing system, such that a set of returns rules is associated with each merchant (see at least Abstract and Col 8, lines 23 – 54 and Figures 1 and 2),
- receiving packages containing returned items at a returns center (see at least Figure 1);
- wherein affixed to each package is a printed label, the label having machine readable data representing at least the identification of a merchant associated with the returned item (see at least Abstract);

- scanning the machine readable data on each package (see at least Col 8, lines 23 – 54);
- correlating at least a portion of the machine readable data with a set of returns rules (see at least Col 6, lines 6, lines 37 – 42, Col 8, lines 23 – 54);
- notifying the merchant of a returned package, based on the results of the correlating step (see at least Col 2, lines 49 – 67).

Regarding Claim 3

Hauser discloses a method, wherein the machine-readable data further identifies a purchase transaction (Figure 2).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**2. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser in view of “Cattron acquires Theimeg”; Modern Material Handling, Boston; Oct 2000 and hereafter referred to as “ReturnValet 1”.**

Hauser discloses the claimed invention except for:

- the return is performed a station closest to the customer.

ReturnValet 1 teaches that it is known to include to perform a return at the returns station closest to the customer (Pages 1 and 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Hauser with the returning to the station closest to the customer of ReturnValet 1, since such a modification would have provided a means for a customer to receive instant credit for a returned item (see at least page 1 of ReturnValet 1).

**3. Claims 4 – 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser as applied to claim 3 above, and further in view of “J. Crew Selects Newgistics ReturnValet Service for Managing Product Returns”, Business Editors, Business Wire; Jan 14, 2002 and hereafter referred to as “ReturnValet 2”.**

Hauser discloses the claimed invention except for:

- the purchase transaction is represented by wherein the purchase an invoice number not disclose a method wherein the purchase a customer number or a product number.

**Regarding Claim 4**

ReturnValet 2 teaches that it is known to include the purchase transaction is represented by wherein the purchase an invoice number (Page 2).

**Regarding claims 5 and 6**

The recitations that “wherein the purchase transaction is represented by a customer number” and “wherein the purchase transaction is represented by a product number” such recitation is given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other “invoice number” already disclosed by ReturnValet 2.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Hauser with representing a purchase transaction with an invoice number, as taught by ReturnValet 2, since such a modification would have provided a means to expedite returns (see at least page 2 of ReturnValet 2).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Misiaszek whose telephone number is (571) 272-6961. The examiner can normally be reached on 8:00 AM - 4:30 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rob Pond can be reached on (571) 272-6760. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael A. Misiaszek  
Patent Examiner  
6/8/2006

  
Michael A. Misiaszek